

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the remarks and amendments herewith. The Examiner is thanked for indicating that claims 37-69 are allowed.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 37-74 are now pending. New claims 73 and 74 have been added, without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

No new matter is added.

It is submitted that these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments to the claims and the remarks herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112; but rather the amendments and remarks are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE ART REJECTIONS ARE OVERCOME

Claim 70 was rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Kim et al. (US 5,344,676). Claim 72 was rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Spiller (US 3,754,975). Claim 71 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Kim et al. (US 5,344,676). The rejections are respectfully traversed and will be addressed in turn.

It is respectfully submitted that a two-prong inquiry must be satisfied in order for a Section 102 rejection to stand. First, the prior art reference must contain **all** of the elements of the claimed invention. *See Lewmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Second, the prior art must contain an enabling disclosure. *See Chester v. Miller*, 15 U.S.P.Q.2d 1333, 1336 (Fed. Cir. 1990). A reference contains an enabling disclosure if a person of ordinary skill in the art could have combined the description of the invention in the prior art reference with his own knowledge of the art to have placed himself in possession of the invention. *See In re Donohue*, 226, U.S.P.Q. 619, 621 (Fed. Cir. 1985).

The Examiner is also respectfully reminded that for a Section 103 rejection to be proper, there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the reference teachings to arrive at the claimed invention. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BPAI 1993). Further, the Examiner is respectfully reminded that “obvious to try” is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.”

And, for the Section 103 rejection to be proper, **both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants’ disclosure.** *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Furthermore, the Examiner is also respectfully reminded that MPEP 2143.01 mandates that for a Section 103 rejection, there must be some suggestion or motivation to modify reference teachings, and, that MPEP 2143.02 further mandates that for a section 103 rejection, there must be a reasonable expectation of success. In view of *KSR*, 82 U.S.P.Q.2d 1396, design incentives and common sense may be considered sufficient motivation to combine or alter a reference, however, an obviousness rejection must still provide sufficient detail to enable an Applicant to respond.

Applicants respectfully submit that the references relied on in the Office Action fails to provide any teaching or suggestion of the present invention. Furthermore, the cited references provide no motivation to modify the teachings of those references or any expectation of success by so modifying. In addition, review of the cited references under the factors provided under *KSR* also provide no incentive to combine the references.

Claim 70 relates to a method of depositing a material in which, *inter alia*, the rate of feeding the material solution, the electric field strength and the temperature gradient are configured such that the droplets decompose and/or react prior to reaching the substrate so as to form a powder.

Applicants incorporate by reference all of the previous argument regarding Kim et al. and expand upon those remarks herein. The Office Action asserts that Kim “teaches a method for applying nanodrops to a substrate to form a coating film or nanoparticles”, which the Office Action equates to a powder. Office Action at 2. In so doing, the Office Action points to Column

3, line 23 of Kim; however, this citation does not provide any information relating to powders or nanoparticles. Applicants respectfully request that the proper citation be provided.

Furthermore, Kim describes the breaking of liquid into “nanoparticles, that is charged liquid clusters.” Kim at Column 3, lines 33-40. Thus, Kim equates “nanoparticles” with “liquid clusters”, **not** powders as asserted by the Office Action.

Accordingly, Kim relates to liquid clusters that form thin films, not powders, as is required by the present invention, rendering the rejection of claim 70 over Kim improper.

Similarly, as Kim does not relate to the formation of films, the obviousness rejection of claim 71 over Kim is also improper, as no reference is provided to remedy this deficiency. In addition, Applicants note that if there was motivation or incentive or common sense to direct the modification of Kim to arrive at the invention of claim 71, one of skill in the art would have expected the art to develop the subject matter of claim 71 prior to the present invention, which was filed seven years after the issuance of Kim.

Regarding the rejection of claim 72, it is respectfully submitted that claim 72 provides a method of depositing a material in which, *inter alia*, a decreasing temperature gradient is provided from the surface of a substrate to an outlet.

Contrary to the allegations in the Office Action, the fact that the substrates (18, 18') are heated to an elevated temperature does not result in a temperature gradient in the manner as required by the claimed invention. Indeed, Spiller requires that the substrates (18, 18') be heated from the surrounding environment, and, in this mode of heating, the environment must be hotter than the substrates (18, 18') in order to effect heat transfer from the environment to the substrates (18, 18'). According, the decreasing temperature gradient of the present invention does not exist.

Therefore, for all of the reasons described above, and as previously provided, reconsideration and withdrawal of the rejections of the application under 35 U.S.C. §102(b) and §103(a) are respectfully requested.

REQUEST FOR INTERVIEW

If any issue remains as an impediment to allowance, prior to issuance of any paper other than a Notice of Allowance, an interview, is respectfully requested, with the Examiner his supervisor, especially as claims 37-69 are deemed allowable, and, the Examiner is respectfully

requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview.

CONCLUSION

In view of the remarks herein the application is in condition for allowance.
Reconsideration and withdrawal of the rejections of the application, and prompt issuance of a notice of allowance is respectfully requested.

Respectfully submitted,
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